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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/904,600 | 07/12/2001 | Greig C. Scott | 05490H028010 | 2591 |
| 22434 | 7590 | 12/30/2005 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250 | | | JUNG, WILLIAM C | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3737 | | |

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/904,600 | SCOTT ET AL. |
| Examiner | Art Unit | |
| William Jung | 3737 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 7, 2005 have been fully considered but they are not persuasive.

After further consideration, examiner respectfully disagrees with the applicant's argument. Glowinski et al clearly anticipates an MR probe conductor loop with two non-magnetic, spaced apart conductors to detect magnetic field. It is unimportant whether the magnetic field is generated by the conducting loop or from external source. Although Glowinski et al do not explicitly state the conductor is placed in a patient, the conducting loop itself is a catheter, which is used invasively along with MR device to locate the position of the catheter. In addition, the applicant's argument on the loop being used with and without the additional magnetic field is not part of the claimed invention and the since Glowinski et al do use with external magnetic field, the argument become moot.

More over, the Nowinski et al's disclosure was to show the retractability of the probe within a catheter or probe. Since, Nowinski et al's device is visible under MR field, the retractability of a sensor or conducting loop is pertinent to the claimed invention.

Therefore, the previous rejection is maintained and repeated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 9, 10, 12, 13, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by *Glowinski et al* (US 5,868,674).

Glowinski et al anticipate all claimed features in claims 1-7, 9, 10, 12, 13, and 15-17.

Claims 1, 2, 5, 6, 9, 13, and 16: Glowinski et al disclose an MR system in which a catheter is placed in a patient within a proximity to the region of interest where the catheter includes conducting loop with two non-magnetic electrode spaced apart from each other, the conductor for detecting MR signals and the catheter is coupled to guide wire or feed wire to manipulate the position of the catheter in the region of interest (col. 1, lines 45-61; col. 4, lines 21-51).

Claims 3 and 4: The conducting medium being tissue for fluid site specific and Glowinski et al inherently disclose the limitation of the fluid or tissue medium by virtue of catheter placed in a patient.

Claims 7, 10, and 17: Glowinski et al disclose in figure 3, element 31 showing that the coils are arranged in saddle coil along the circumference of the catheter (col. 5, lines 15-39).

Claims 12 and 15: Glowinski et al disclose that the catheter is used along with interventional instrument such as biopsy needles (col. 1, lines 57-61).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Glowinski et al* as applied to claims 1-6, 9, and 13-16 above, and further in view of *Nowinski et al* (US 6,701,173).

Glowinski et al substantially disclose all claimed features in claims 8, 11, and 18. However, Glowinski et al do not disclose retractable electrodes that extend out from within the catheter. Nowinski et al disclose the above deficiency where the retractable electrode is shown in figure 23B. Although Nowinski et al's device is not particularly for MR system, the catheter and the electrode within the catheter is MR visible. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply the teachings of Nowinski et al with Glowinski et al's disclosure above to improve the catheter device with retractable electrode.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WC
December 20, 2005

Elen Mantis-Mercader
ELEN MANTIS-MERCADER
PRIMARY EXAMINER